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EXAMINER
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GARLAND, STEVEN R

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*Technology Center 2100*

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/686,626  
Filing Date: October 12, 2000  
Appellant(s): SATCHELL ET AL.

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Thomas P. Pavelko  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 12, 2007 appealing from the Office action mailed June 28, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after the non-final second rejection, being appealed from, has been filed. However a supplemental interview summary for an interview previously held on April 28, 2003, with accompanying declarations relating only to the proceedings of the interview held on April 28, 2003, was filed on September 6, 2006. The original interview summary by applicant was previously filed on May 28 2003 at page 4 of the response of May 28, 2003. The supplemental interview summary and declarations relating to the interview have been noted by the examiner and will not be commented on further.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth

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paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. The brief is deficient because the definition of the term "Internet" which is set forth on page 4 lines 39-42 and which has been given a special meaning by applicant has been overlooked from the explanation of independent claims 31, 97, 100, 112, 114, 127, and 133. Also the meaning of the terms of website or homepage used in independent claims 97, 100, 114, 127, and 130 should also be viewed in light of the specification at page 2, lines 2-4, 16-17, and 55-64 for a proper understanding of the claimed invention.

#### **(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

#### **(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

#### **(8) Evidence Relied Upon**

5,953,504	SOKAL ET AL.	9-1999
5,637,845	KOLLS	6-1997
5,513,117	SMALL	4-1996
5,445,295	BROWN	8-1995
5,239,480	HUEGEL	8-1993
5,090,589	BRANDES ET AL.	2-1992
4,839,505	BRADT ET AL.	6-1989
RE.32,115	LOCKWOOD ET AL.	4-1986

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 114-127, 129 and 130 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The Pannu court stated that the Clement test for determining the presence of recapture or lack thereof as a three step analysis:

Application of the recapture rule is a three step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." ... "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." ... "Finally, the

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court must determine whether the reissued claims were materially narrowed in other aspects to avoid the recapture rule. Pannu 59 USPQ2d at 1600.

As to the first step, claims 114-127, 129, and 130 are all method claims which are all broader than the apparatus claims 1-12 of the patent, since they do not specify a particular vending machine structure as in the patent claims

In the following explanation claim 114 is used as an example and a similar analysis can be made for the other rejected claims.

As to the second step, Claim 1, as originally filed in the patent application, was to

"a vending machine for sale of items selected by a customer comprising:

a storage unit for storing a plurality of items for sale and a dispensing mechanism for dispensing the items from the storage unit;

a selector device for selecting one or more of said items for sale by the customer;

a payment-control device for receiving and detecting an amount of payment required for the sale of an item and for actuating said dispensing mechanism when a payment is received to dispense a selected item; and

a computer assembly connected to said storage and dispensing unit, selector device and payment control device and having a computer, video display screen and a modem, whereby said computer is connected to and actuated by said selector device for automatically connecting said computer to a pre-selected internet site and automatically displaying information obtained from said internet site on said video

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screen for viewing by the customer said computer assembly further including customer actuating means for enabling a customer to interface with said computer."

Claims 1-9 were rejected under 35 U.S.C. 103 in the office action 10/6/97.

In response to the rejection claim 1 was amended to recite a vending machine having a door for retrofitting an existing vending machine consistent with allowable claim 10 in the amendment of 12/30/97.

Claims as broad or broader than the scope of original claim 1 are then surrendered subject matter and can not be recaptured.

As to the final step, for example new reissue claim 114 is directed to " A method of providing a customer with access to the Internet via a vending machine, said method comprising

1.) providing a vending machine to vend at least one physical item selected by a customer for purchase;

2.) said purchase of said at least one item permits the customer to be operatively connectable via the Internet to websites;

3.) allowing access to the websites by said customer, said access comprising at least one of inserting money or credit card information into the vending machine and customer input of data to the computer. "

New method claim 114 is clearly broader in scope than the surrendered subject matter of original claim 1, since specific details of the vending machine are not given such as whether a modem is used. Further reissue claim 114 entirely omits the retrofitting door limitation that was added to overcome the art rejection. The claim also

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adds limitations that are not related to the previously surrendered subject matter in the form of limitations of a purchase allows the customer to be operatively connected to the Internet. Such claims are barred by the recapture rule. See *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 (Fed. Cir. 1997).

The retrofitting door aspects "surrender generating limitations" have been omitted from these claims resulting in improper recapture. The retrofitting door was indicated as being the reason for allowance of originally numbered claim 10 in the parent patent in the office action of 10/6/97. Further in the amendment filed 12/30/97 by the applicant it was stated that claim 1, the only other independent claim in the application, was being amended to recite a vending machine having a door for retrofitting an existing vending machine consistent with allowable claim 10. The response further stated that in view of the indication of Allowability of claim 10, these amendments are submitted to place claim 1 in condition for allowance with all the other remaining claims being dependent on claim 1 as amended. The application was then allowed without additional amendment and no additional comments in regards to the allowed claims were made by the applicants. All the rejected claims fail to claim the retrofitting door.

In response to applicant's arguments, originally filed claims 1-9 in the patent were amended to avoid an art rejection by adding the retrofitting door aspects. Applicant can not now broaden the claims to recapture subject matter broader than that previously surrendered in original claims 1-9 of the parent patent application. See *In re Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165 (Fed. Cir. 1997).



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Further applicant is not prevented from presenting broaden reissue method claims. Applicant appears to imply that the position held by the examiner requires that no broadening of a patent claim would ever be allowed. The examiner's position is that recapture places a limit on the amount broadening of any reissue claims whether apparatus or method, since claims lacking the surrender generating limitation are barred by recapture. The rejected claims all fail to recite the retrofitting door limitations "surrender generating limitations" and are rejected under capture.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 31-41,60-64,66,68,69,71-108,110-112, 127, and 129-134 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradt et al. 4,839,505 in view of Sokal et al. 5,953,504.

With respect to claims 31, 97,100 101,104, 112,127,130,133 ,Bradt et al. teaches a vending machine 10 with a hinged door ( 16, fig. 1) having a computer, modem, display, credit card reader, and bill or coin acceptor mounted on the door. Bradt also teaches that the computer can send and receive information from a remote site such as the owner or by linking to a credit card company. Bradt further teaches that the dispensed items can be video tapes, music disks, or other items, dispensing the items through the door, storing the items in the machine, use of a keypad, and advertising when the machine is available. See the abstract; figures; col. 1, lines 9-13;

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col. 2, lines 26-42; col. 7, line 29 to col. 8, line 31; col. 9, lines 27-60; col. 10, lines 19-45; col. 12, lines 3-18, col. 13, line 66 to col. 13, line 68; col. 18, lines 30-58; col. 19, lines 49-55; col. 24, lines 55-60; col. 33, lines 52-65; and also note fig. 2.

Also it is noted that applicant provides a special definition of "Internet" which is set forth on page 4 lines 39-42 of the instant specification and which must be given weight when interpreting independent claims 31, 97, 100, 112, 114, 127, and 133 and their dependent claims. Also the meaning of the terms of website or homepage used in independent claims 97, 100, 114, 127, and 130 should also be viewed in light of the specification, at page 2, lines 2-4, 16-17, and 55-64, for a proper understanding of the claimed invention.

Bradt however does not specifically teach Internet access using a vending machine.

Sokal et al. teaches allowing public access to the Internet including a pay per view which only allows information dispensing after funds are paid, use of a computer, payment means, use of removable memory means, display, key pad, camera, microphone, speaker, modem, attracting customers, server, display of a home page which requires the use of a browser and software ( figs. 4,5), downloading information, sending receiving audio/video information, CD-ROM reading/mastering, display time to browse, connecting to a business web site. See the abstract; figures; col. 1, line 6 to col. 2, line 25; col. 3, line 8 to col. 5, line 23; col. 6, line 26 to col. 7, line 12; and the claims.

It would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal and modify the vending machine and its door to incorporate the Internet

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access functions taught by Sokal. This would allow a wider range of transactions and increase the revenue from the machine. The additional revenue generated by the more diverse functions of Bradt/Sokal could be attained at a marginal increased cost to the owner/operator since most if not all the necessary hardware would already be present in the machine door of Bradt. The above mentioned claim(s) are (is) reproduced below for convenience.

Claims 31 a door for retrofitting an existing vending machine for dispensing of at least one item selected by a customer, said door comprising: a delivery port, for dispensing said at least one item selected by a customer to the customer; and an access portal to the Internet on said door for interaction of the customer with the Internet.

Claim 101. The door for retrofitting an existing vending machine of claim 31, further comprising software for browsing the Internet.

Claim 104. The door for retrofitting an existing vending machine of claim 31, further comprising software for connecting a computer with an Internet site.

Claim 97. A combination of a computer and selector provided on a door for retrofitting an existing vending machine for dispensing at least one item selected for purchase by a customer, wherein said computer is connected to and activated by said selector for connecting said computer to the Internet and conveying information from the Internet to a web site or homepage of a manufacturer of the item purchased, or the web site or homepage of an owner or operator of the vending machine.

Claim 100. A combination of a computer and selector provided on a door for retrofitting an existing vending machine for dispensing at least one item selected by a customer, wherein said computer is connected to and activated by selector device for connecting to a web site or homepage of a web site of an Internet provider.

Claim 112. A door for retrofitting an existing vending machine for sale of items selected by a customer, said door comprising: a selector device for selecting one or more of said items for sale by the customer; a payment-control device for receiving and detecting an amount of payment; and a video display screen for providing interactions by the customer with the Internet.

Claim 127. A method of attracting greater patronage to a vending machine, said method comprising: providing a vending machine with a connection to the internet/worldwide web; and permitting a customer access to websites on said internet/worldwide web through interaction with said vending machine, wherein at least part of said access is located on a door of the vending machine.

Claim 130. A method of manufacturing vending machines wherein a vending machine is provided to dispense an article to be purchased by a consumer, the improvement comprising incorporating an interactive consumer accessible internet communication system into the vending machine to permit the customer access to websites.

Claim 133. A door for a vending machine for sale of items selected by a customer, said door comprising: a dispensing mechanism for dispensing an item from among a plurality of items stored in a storage unit of said vending machine,

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a selector device permitting the customer to select one or more of said items for sale, a payment-control device capable of receiving and detecting an amount of payment required for a sale of an item, and an access portal to the Internet on said door for interaction of the customer with the Internet.

With respect to dependent claim 32, Bradt teaches a vending machine 10 with a door 16 and item storage 40 of an item to be selected by the customer. Therefor the limitations of the claim are taught or suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 32. A vending machine comprising the door of claim 31, said vending machine further including a storage unit for storing said at least one item for selection by a customer.

With respect to dependent claim 33, Bradt teaches a door with a dispensing mechanism (28, etc. fig. 2 of Bradt). Therefor the limitations of the claim are taught or suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 33. The vending machine of claim 32, wherein said door further comprises a dispensing mechanism for dispensing said at least one item.

With respect to dependent claims 34, 35, 110, 111 Bradt teaches the use of a modem 36 to allow communication with a host, uploading/downloading data from databases (col. 8, lines 28-31; col. 9, lines 58-60; col. 13, lines 47-68, col. 19, lines 49-55) and Sokal teaches the use of a modem 41 for interaction with other remote

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systems such as a server (12,10) or terminal (14,15,16). Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. In addition it would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal and allow communication with a server host connected to multiple vending machines and allow the host server to service multiple machines as taught by Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 34. The vending machine of claim 32, wherein at least one of a telephone connection, cable, modem, antenna, and satellite dish is provided for interacting with other transmitters and receivers.

Claim 35. The vending machine of claim 34, wherein the other receiver is capable of receiving and utilizing data.

Claim 110. The door for retrofitting an existing vending machine of claim 31, further comprising an interface to a communication network to access an on-line computer service, wherein said service is capable of transmitting and receiving, via a communication network, a request for service by a customer and a response to said request.

Claim 111. The vending machine of claim 32, further comprising a transmit-receive circuit connecting the vending machine with other transmitters and receivers.

With respect to dependent claim 36, . Bradt further teaches that the dispensed items can be video tapes, music disks, or other items (abstract, lines 1-3, col. 33, lines 52-60). Therefor the limitations of the claim are taught or fairly suggested by the

combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 36. The vending machine of claim 32, wherein said selected item is at least one item selected from the group consisting of cans, bottles, hot and cold drinks in cups, sandwiches, candy, combs, money, CD-ROM, diskettes, and laser-discs.

With respect to dependent claims 37-41, 95 Bradt teaches the use of a modem 36 to allow communication with a host, uploading/downloading data (col. 8, lines 28-31; col. 9, lines 58-60; col. 13, lines 47-68). Bradt however does not teach storage of audio/video material or uploading/downloading of such material, use of a camera, or microphone. Sokal teaches the use of a modem 41 for interaction with other remote systems such as a server (12,10) or public access terminal (14,15,16). Sokal in addition teaches allowing communication between various users including teleconferencing ( col. 1, lines 8-12, col. 6, lines 34-40) and using various medium to record information (23,25) such as floppy disk or CD ROM . Sokal further provides a camera 34, microphone, and speaker 36 to allow communication with a user (col. 4, lines 22-27). Sokal teaches that the terminal receives information that is transmitted to it or supplied to it from units 23,25 (uploading) and that the CPU is connected to the camera, microphone, modem, units 23, 25, etc. (col. 3, lines 28-38) . Sokal also teaches downloading information (col. 8, lines 21-23) and saving it which could include audio/video if videoconferencing. Sokal further teaches that video conferencing includes using a camera (video) , speaker and microphone (audio) in col. 6, lines 34-40. In view of these teachings of Sokal it is evident, but not expressly stated, that audio/video

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signals can be recorded/transmitted from/to a remote site or stored locally in the apparatus of Sokal.

It would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal and allow uploading/downloading audio/video signals generated from a camera and microphone to a storage medium. This would allow teleconferencing, provide a record of a teleconference, and provide the numerous additional benefits taught by Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 37. The vending machine of claim 32, further comprising: at least one mechanism selected from the group including data storage unit, programmable audio-video message storage unit, laser-disc, read-write CD-ROM, read only memory recording medium, magnetic media and diskette for storage of data and recording, storage and playback of audio and video signals, wherein a customer is enabled respectively to upload and download audio and video signals from and to said mechanism to and from websites and home pages, and to send and receive data from and to said mechanism to and from other data transmitters or receivers.

Claim 38. The vending machine of claim 37, further comprising: a camera connected to a computer for generating video signals; and a microphone connected to a computer for generating audio signals, wherein said microphone generated audio and camera generated video signals are recorded alone or in combination with already recorded audio and visual signals by said at least one mechanism.

Claim 39. The vending machine of claim 32, further comprising: a camera



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connected to a computer for generating video signals; a microphone connected to said computer for generating audio signals; and  
at least one audio-video mechanism connected to said computer for recording said audio and video signals.

Claim 40. The vending machine of claim 39, wherein said signals provide a two-way communication via the Internet.

Claim 41. The vending machine of claim 40, wherein said at least one audio-video mechanism is selected from the group consisting of data storage mechanism, laser-disc, read-write CD-ROM, and diskette, whereby said signals are recorded by said at least one audio-video mechanism and dispensed to the customer.

Claim 95. The vending machine of claim 37, wherein said programmable audio-video message storage unit comprises at least one of an optical recording medium, a magnetic recording medium, and an electrically eraseable and programmable read-only memory recording medium.

With respect to dependent claim 60, Bradt teaches the use of a modem 36 to allow communication with a host, uploading/downloading data from databases (col. 8, lines 28-31; col. 9, lines 58-60; col. 13, lines 47-68, col. 19, lines 49-55) and Sokal teaches the use of a modem 41 for interaction with other remote systems such as a server (12,10) or terminal (14,15,16). Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 60. The door for retrofitting an existing vending machine of claim 31, further comprising at least one of a telephone connection, cable, modem, antennae and satellite dish.

With respect to dependent claims 61, 88, 89, 94, 96 Bradt teaches a coin or bill acceptor 19 and Sokal teaches a money acceptor 29. Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 61. The door of claim 31, further comprising a money delivery port.

Claim 88. The vending machine of claim 32, further comprising means for accepting payment.

Claim 89. The vending machine of claim 88, wherein the payment comprises at least one of coins, bills and credit cards.

Claim 94. The vending machine of claim 32, further comprising an amount deposit acceptor.

Claim 96. The vending machine of claim 32, further comprising a payment control device.

With respect to claim 62, Bradt and Sokal do not expressly state that the machine dispenses change. It would have been obvious to one of ordinary skill in the art to modify Bradt and Sokal to dispense money in the form of returning change for a purchase if for no other reason than to prevent vandalism to the machine. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 62 . The vending machine of claim 32, wherein said dispensed item is money.

With respect to claims 63, 68, 71, 79, 80, 83, 84, 86, 90, 91 Bradt teaches the use of a modem 36 to allow communication with a host including an owner/operator, uploading/downloading data (col. 8, lines 28-31; col. 9, lines 58-60; col. 13, lines 47-68). Bradt however does not teach storage of audio/video material or uploading/downloading of such material, use of a camera accepting visual input, or microphone. Sokal teaches the use of a modem 41, connected to the CPU ( video to digital conversion ) for interaction with other remote systems such as a server (12,10) or public access terminal (14,15,16). Sokal in addition teaches allowing communication between various users including videoconferencing using a video interfacing ( col. 1, lines 8-12, col. 6, lines 34-40) and using various medium to record information (23,25). Sokal further provides a camera 34, microphone, and speaker 36 to allow communication with a user (col. 4, lines 22-27). Sokal teaches that the terminal receives information that is transmitted to it or supplied to it from units 23,25 (uploading) and that the CPU is connected to the camera, microphone, modem, units 23, 25, etc. (col. 3, lines 28-38) . Sokal also teaches downloading information (col. 8, lines 21-23) and saving it which can include audio/video if videoconferencing. Sokal further teaches that video conferencing includes using a camera (video) , speaker and microphone (audio) in col. 6, lines 34-40. In view of these teachings of Sokal it is evident, but not expressly stated, that audio/video signals can be recorded/transmitted from/to a remote site or stored locally in the apparatus of Sokal.

It would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal and allow teleconferencing to another customer or owner/operator,

uploading/downloading audio/video signals generated from a camera and microphone to a storage medium. This would allow teleconferencing, provide a record of a teleconference, allow prompt service by the owner/operator in case of malfunction and provide the numerous additional benefits taught by Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 63. The door for retrofitting an existing vending machine of claim 31, wherein said door further comprises means for two-way interactive communications by a customer with the Internet.

Claim 68. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprises a camera.

Claim 71. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprises a microphone.

Claim 79. The vending machine of claim 32, wherein said vending machine is connected to an Internet service provider by a communication network system which enables two-way multimedia interactive communication with a customer.

Claim 80. The vending machine of claim 32, further comprising transmitting and receiving network communication means and content uploading and downloading means to and from Internet sites so as to enable communication between a customer and an owner or operator of said vending machine.

Claim 83. The vending machine of claim 32, further comprising at least one of an audio or a video interface circuit for two-way interactive communication.

Claim 84. The vending machine of claim 83, wherein the interface circuit for two-

way interactive communication is a video interface circuit.

Claim 86. The door for retrofitting an existing vending machine according to claim 63, wherein the interactive communications are interactive visual communications.

Claim 90. The vending machine of claim 32, further comprising means for accepting visual input.

Claim 91. The vending machine of claim 90, further comprising means for converting said visual input to digital form.

With respect to claim 64, Bradt teaches a CRT 24 to display video information and Sokal teaches the use of screen 21 to display information. Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 64. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprises a video screen.

With respect to claims 66,77,78 Bradt teaches the use of a keypad 22 connected to the computer and Sokal also teaches a keypad 22 and touch sensitive display 21 which serves as keypad to select various sites (figs. 4,5) connected to the computer to accept customer input. Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 66. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprises a keypad.

Claim 77. The door for retrofitting an existing vending machine according to claim 31, further including means to accept input from a customer.

Claim 78. The door for retrofitting an existing vending machine according to claim 77, wherein a computer is also connected to the means to accept input from a customer.

With respect to claims 69,76,81,82, 102,103,105-107, Bradt does not teach a programmable selection panel but does teach contacting the owner/operator (col. 8, lines 24-31). Bradt also does not teach connecting to an Internet service provider prior to dispensing information. Sokal however teaches the use of a programmable selection panel ( touch sensitive display 21 which serves as a keypad) for selecting various websites, as shown in figures 4 and 5 and their description, and which allows ease in selection by the user. It would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal to use such a selection means to select between the various sites for customer ease such as to contact the owner in case of a malfunction or to request a refund. Further Sokal teaches requiring payment before allowing general Internet access which in turns allows information to be dispensed to the user. It would have been obvious to one of ordinary skill in the art to modify Bradt and Sokal in view of the teaching of Sokal to only allow dispensing information after paying for access. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 69. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprises a programmable selection panel for selecting

websites or home pages to transmit-receive data, music, video and audio and to provide visual and digital recording functions.

Claim 76. The door for retrofitting an existing vending machine according to claim 31, further including a programmable selection panel for selecting web sites, home pages of web sites, and on-line computer services to provide at least one of data, music or video.

Claim 81. The vending machine of claim 32, further comprising programmable means to connect the machine to a website or homepage of a manufacturer of the item selected.

Claim 82. The vending machine of claim 32, further comprising programmable means to connect the machine to a web site or homepage of an owner or operator of the vending machine.

Claim 102. The door for retrofitting an existing vending machine of claim 78, wherein the computer displays a homepage or website, together with information from an Internet provider.

Claim 103. The vending machine of claim 102, wherein the computer is connected to the Internet provider via the Internet before the item is dispensed.

Claim 105. The door for retrofitting an existing vending machine of claim 31, wherein an Internet site is selected from the group consisting of an Internet provider, a manufacturer of the item, a vendor of the item, an internet site specified by the customer, an owner of the vending machine, an operator of the vending machine, news web sites, financial web sites, music web sites and an interact site of the property owner

where the vending machine is located.

Claim 106. The vending machine of claim 32, further comprising software for automatically connecting the vending machine to a specific Internet web site.

Claim 107. The vending machine of claim 106, wherein the specific Internet website transmits and receives at least one of data, audio or video signals.

With respect to claim 85 which is dependent on claim 82, Bradt does not teach downloading the selection and saving it on a mobile medium. Sokal further teaches downloading information (col. 8, lines 21-23) and saving it on a mobile medium. Therefor it would have been obvious to one of ordinary skill in the art modify Bradt in view of Sokal and download and save the information in view of the express teaching of Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 85. The vending machine of claim 82, further comprising means to download a communication onto a mobile recording medium.

With respect to claims 72, 87, Bradt teaches the use of a credit card reader 18 and Sokal teaches the use of a credit card reader 30. Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 72. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprises a credit card reader.

Claim 87. The vending machine of claim 32, further comprising a credit card acceptor.

With respect to claims 73 and 75, Bradt does not display pricing information for



the Internet. Sokal teaches accessing the Internet for a fee based on pay per view, calculating the fee and the period of use, displaying the fee for the access time ( amount of time remaining), not allowing access if the fee paid is insufficient ( col. 1, lines 44-48; col. 2, lines 18-25; col. 5, lines 3-16 ). It would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal and provide pay for view access to the Internet and increase revenue form the machine at marginal additional cost, since most of the necessary hardware would already be present in the machine of Bradt. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 73. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprising means for displaying pricing information for the Internet.

Claim 75. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprising means to display time left to browse web sites.

With respect to claim 74, Bradt teaches that CPU can be an IBM compatible microcomputer and be MS/DOS driven such a computer would inherently require and have a scratchpad memory to store temporary results or work in progress of the operating system. Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 74. The door for retrofitting an existing vending machine according to claim 31, wherein the door further comprises a scratch pad memory unit.

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With respect to claims 92 and 93, Bradt teaches connecting a vending machine to a preprogrammed business (financial ) site ( col. 13, lines 47-55). Sokal also teaches connecting to preprogrammed business site (fig. 4) and downloading information col. 5, lines 21-23. Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 92. The vending machine of claim 91, further comprising a communications network to connect the vending machine to a pre-programmed financial web site.

Claim 93. The vending machine of claim 92, further comprising means to download information from said financial web site.

With respect to claims 98,99 Bradt teaches that the CPU can be microprocessor (digital processor) and which receives and outputs data (interfacing such as a modem). Sokal also teaches the use of a processor for the CPU 40 and a modem (interfacing). Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 98. The door for retrofitting an existing vending machine according to claim 31, further comprising at least one of a programmable microprocessor and an interface circuit.

Claim 99. The door for retrofitting an existing vending machine according to claim

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31, further comprising at least one of a digital signal processing unit and an interface circuit.

With respect to claims 108,129 Bradt teaches display of advertising when the machine is idle (col. 18, lines 33-58) and Sokal teaches advertising when idle ( col. 4, lines 39-44). Therefor the limitations of the claim are taught or fairly suggested by the combined teachings of Bradt et al. and Sokal. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 108. The vending machine of claim 32, further comprising means to display advertising when the vending machine is idle.

Claim 129. The method of claim 127, wherein the access displays at least one of informational, entertainment or advertising when a patron is not accessing the internet/worldwide web.

With respect to claims 131,132,134, Bradt does not specifically state that drinks can be dispensed, but does teach that various items can be dispensed ( abstract, col. 33, lines 52-55).

It would have been obvious to one of ordinary skill in the art to modify Bradt and Sokal in view of the teaching of Bradt and dispense other items such as drinks in cans or bottles forms to allow use of the machine in common vending machine locations and increased sales. The above mentioned claim(s) are (is) reproduced below for convenience.

Claim 131. The door for retrofitting an existing vending machine according to claim 31, wherein said at least one item selected is a drink.

Claim 132. The vending machine according to claim 32, wherein said at least one item selected is a drink.

Claim 134. The door of claim 133, wherein the item selected by the customer is a drink.

Claims 65 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradt et al. 4,839,505 in view of Sokal et al. 5,953,504 as applied to claims 31-41, 60-64, 66, 68, 69, 71-108, 110-112, 127, and 129-134 above, and further in view of Brown 5,445,295.

Bradt et al. teaches a vending machine 10 with a hinged door ( 16, fig. 1) having a computer, modem, display, credit card reader, and bill or coin acceptor mounted on the door. Bradt also teaches that the computer can send and receive information from a remote site such as the owner or by linking to a credit card company. Bradt further teaches that the dispensed items can be video tapes, music disks, or other items, dispensing the items through the door, storing the items in the machine, use of a keypad, and advertising when the machine is available. See the abstract; figures; col. 1, lines 9-13; col. 2, lines 26-42; col. 7, line 29 to col. 8, line 31; col. 9, lines 27-60; col. 10, lines 19-45; col. 12, lines 3-18, col. 13, line 66 to col. 13, line 68; col. 18, lines 30-58; col. 19, lines 49-55; col. 24, lines 55-60; col. 33, lines 52-65; and also note fig. 2.

Bradt however does not specifically teach Internet access using a vending machine.

Sokal et al. teaches allowing public access to the Internet including a pay per view which only allows information dispensing after funds are paid, use of a computer,

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payment means, use of removable memory means, display, key pad, camera, microphone, speaker, modem, attracting customers, server, display of a home page which requires the use of a browser and software ( figs. 4,5), downloading information, sending receiving audio/video information, CD-ROM reading/mastering, display time to browse, connecting to a business web site. See the abstract; figures; col. 1, line 6 to col. 2, line 25; col. 3, line 8 to col. 5, line 23; col. 6, line 26 to col. 7, line 12; and the claims.

It would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal and modify the vending machine and its door to incorporate the Internet access functions taught by Sokal. This would allow a wider range of transactions and increase the revenue from the machine. The additional revenue generated by the more diverse functions of Bradt/Sokal could be attained at a marginal increased cost to the owner/operator since most if not all the necessary hardware would already be present in the machine door of Bradt.

Bradt and Sokal however do not teach the use of plural speakers or headphones. Sokal does teach the use of a speaker.

Brown teaches the alternatives of headphones or speakers in a vending machine. See col. 5, lines 1-5.

It would have been obvious to one of ordinary skill in the art to modify Bradt and Sokal in view of Brown and provide the device with plural speakers for improved sound or headphones for private listening and to reduce background noise.

Claims 67 and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bradt et al. 4,839,505 in view of Sokal et al. 5,953,504 as applied to claims 31-

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41,60-64,66,68,69,71-108,110-112, 127, and 129-134 above, and further in view of Small 5,513,117.

Bradt et al. teaches a vending machine 10 with a hinged door ( 16, fig. 1) having a computer, modem, display, credit card reader, and bill or coin acceptor mounted on the door. Bradt also teaches that the computer can send and receive information from a remote site such as the owner or by linking to a credit card company. Bradt further teaches that the dispensed items can be video tapes, music disks, or other items, dispensing the items through the door, storing the items in the machine, use of a keypad, and advertising when the machine is available. See the abstract; figures; col. 1, lines 9-13; col. 2, lines 26-42; col. 7, line 29 to col. 8, line 31; col. 9, lines 27-60; col. 10, lines 19-45; col. 12, lines 3-18, col. 13, line 66 to col. 13, line 68; col. 18, lines 30-58; col. 19, lines 49-55; col. 24, lines 55-60; col. 33, lines 52-65; and also note fig. 2.

Bradt however does not specifically teach Internet access using a vending machine.

Sokal et al. teaches allowing public access to the Internet including a pay per view which only allows information dispensing after funds are paid, use of a computer, payment means, use of removable memory means, display, key pad, camera, microphone, speaker, modem, attracting customers, server, display of a home page which requires the use of a browser and software ( figs. 4,5), downloading information, sending receiving audio/video information, CD-ROM reading/mastering, display time to browse, connecting to a business web site. See the abstract; figures; col. 1, line 6 to col. 2, line 25; col. 3, line 8 to col. 5, line 23; col. 6, line 26 to col. 7, line 12; and the claims.

It would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal and modify the vending machine and its door to incorporate the Internet access functions taught by Sokal. This would allow a wider range of transactions and increase the revenue from the machine. The additional revenue generated by the more diverse functions of Bradt/Sokal could be attained at a marginal increased cost to the owner/operator since most if not all the necessary hardware would already be present in the machine door of Bradt.

Bradt and Sokal however do not teach the use of a mouse or trackball.

Small teaches the alternatives of a mouse or trackball for data input into a vending machine. See col. 6, lines 60-65.

It would have been obvious to one of ordinary skill in the art to modify Bradt and Sokal in view of Small and allow for data entry using a mouse or trackball for ease in selecting items.

Claim 109 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bradt et al. 4,839,505 in view of Sokal et al. 5,953,504 as applied to claims 31-41, 60-64, 66, 68, 69, 71-108, 110-112, 127, and 129-134 above, and further in view of Brandes et al. 5,090,589.

Bradt et al. teaches a vending machine 10 with a hinged door (16, fig. 1) having a computer, modem, display, credit card reader, and bill or coin acceptor mounted on the door. Bradt also teaches that the computer can send and receive information from a remote site such as the owner or by linking to a credit card company. Bradt further teaches that the dispensed items can be video tapes, music disks, or other items,

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dispensing the items through the door, storing the items in the machine, use of a keypad, and advertising when the machine is available. See the abstract; figures; col. 1, lines 9-13; col. 2, lines 26-42; col. 7, line 29 to col. 8, line 31; col. 9, lines 27-60; col. 10, lines 19-45; col. 12, lines 3-18, col. 13, line 66 to col. 13, line 68; col. 18, lines 30-58; col. 19, lines 49-55; col. 24, lines 55-60; col. 33, lines 52-65; and also note fig. 2.

Bradt however does not specifically teach Internet access using a vending machine.

Sokal et al. teaches allowing public access to the Internet including a pay per view which only allows information dispensing after funds are paid, use of a computer, payment means, use of removable memory means, display, key pad, camera, microphone, speaker, modem, attracting customers, server, display of a home page which requires the use of a browser and software ( figs. 4,5), downloading information, sending receiving audio/video information, CD-ROM reading/mastering, display time to browse, connecting to a business web site. See the abstract; figures; col. 1, line 6 to col. 2, line 25; col. 3, line 8 to col. 5, line 23; col. 6, line 26 to col. 7, line 12; and the claims.

It would have been obvious to one of ordinary skill in the art to modify Bradt in view of Sokal and modify the vending machine and its door to incorporate the Internet access functions taught by Sokal. This would allow a wider range of transactions and increase the revenue from the machine. The additional revenue generated by the more diverse functions of Bradt/Sokal could be attained at a marginal increased cost to the owner/operator since most if not all the necessary hardware would already be present in the machine door of Bradt.



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Bradt and Sokal however do not teach the use of backlighting.

Brandes et al. teach the use of a plate and backlighting on a vending machine.

See the abstract and col. 4, lines 34-43.

It would have been obvious to one of ordinary skill in the art to modify Bradt and Sokal in view of Brandes and use backlighting and a plate on the front of the vending machine to promote use of the machine and allow the controls to be conveniently grouped.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 130 is rejected under 35 U.S.C. 102(e) as being anticipated by Sokal et al. 5,953,504.

Sokal et al. teaches providing a vending machine (fig. 2), allowing public access to the Internet (abstract), use of a computer, payment means, use of removable memory means 23,25, display, key pad, camera, microphone, speaker, modem, downloading information, sending receiving audio/video information, printing the screen display which also serves to dispense an item ( col. 4, lines 28-33), CD-ROM reading/mastering unit which serves to also dispense a recorded disk ( col. 3, line 64 to

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col. 4, line 5). See the abstract; figures; col. 1, line 6 to col. 2, line 25; col. 3, line 8 to col. 5, line 23; col. 6, line 26 to col. 7, line 12; and the claims. The above mentioned claim is reproduced below for convenience.

Claim 130. A method of manufacturing vending machines wherein a vending machine is provided to dispense an article to be purchased by a consumer, the improvement comprising incorporating an interactive consumer accessible internet communication system into the vending machine to permit the customer access to websites.

Claim 130 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Huegel 5,239,480.

Huegel teaches a vending machine (self service terminal) and computer, audio/video advertising, use of a credit card, use of a modem and server to connect to remote sites. See the figures, col. 2, line 28 to col. 3, line 3; col. 5, line 1 to col. 6, line 64; col. 8, lines 39-44; col. 9, lines 34-54.

Claim 130.	Huegel
A method of manufacturing vending machines	col. 2, lines 35-36, 66-68
wherein a vending machine is provided	
to dispense an article to be purchased by a consumer,	
the improvement comprising	abstract, figure 1 (self
incorporating an interactive consumer accessible	service terminal)
internet communication system into the vending machine	col. 6, lines 10-21
to permit the customer access to websites.	websites 41,43

Huegel however does not specifically mention the terminology websites ( also note page 2, lines 2-4,16-17, and 55-64 of the instant specification ), but does teach remote access of computer sites.

These remote sites of Huegel are obviously if not inherently "websites " given the broad Internet definition set forth on page 4, lines 39-42, of the instant specification in which the Internet term is said to refer to numerous computer databases and on-line services available for public access for retrieving and/or sending information. The remote sites of Huegel by this broad definition would be websites as appear to be defined by applicants.

Claim 130 is rejected under 35 U.S.C. 102(e) as being anticipated by Kolls 5,637,845.

Kolls teaches a vending machine for allowing Internet access. Kolls teaches the use of a computer, monitor, memory, speaker, card reader, keypad, modem, tracking use time, purchasing access time to the Internet ( dispensing an article as access time), use of a credit card See col. 1, lines 23-28; col. 4, lines 27-34; col. 6, lines 10-34; col. 15, line 23 to col. 20, line 61; and the figures. Further Kolls provides for purchasing time to access the Internet as noted in the above sections, vending copies at additional cost, etc. Note figures 13 on and col. 17, lines 40-65 for example.

Claim 130.

Kolls

A method of manufacturing vending machines

fig. 13, system 400 with PC 402

controller 12, wherein a vending machine is provided

modem 420, printer 414

to dispense an article to be purchased by a consumer, col. 17, lines 44-50

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the improvement comprising

incorporating an interactive consumer accessible col. 16, lines 18-27

internet communication system into the vending machine

to permit the customer access to websites.

These remote sites of Kolls are obviously if not inherently "websites " given the broad Internet definition set forth on page 4 of the instant specification in which the Internet term is said to refer to numerous computer databases and on-line services available for public access for retrieving and/or sending information. The remote sites of Kolls by this broad definition would be websites as appear to be defined by applicants.

Claim 130 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lockwood et al. Re. 32,115.

Lockwood et al. teaches a vending machine 23 and computer 30, use of coins or a credit card, accessing various remote information sources ( col. 1, line 67 to col. 2, line 23). See the abstract; figures; col. 1, line 67 to col. 2, line 23; col. 3, lines 4-50; col. 4, lines 50-55; col. 5, line 32 to col. 6, line 66; col. 7, line 16 to col. 8, line 49; and the claims. Note in particular claim 8.

Claim 130.

Lockwood

A method of manufacturing vending machines

terminal 1

wherein a vending machine is provided

to dispense an article to be purchased by a consumer, dispenser 23

the improvement comprising

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incorporating an interactive consumer accessible remote site computer 42;  
internet communication system into the vending machine col. 7, lines 55-60;  
to permit the customer access to websites. col. 8, lines 21-29;  
col. 10, lines 60-64.

Lockwood however does not specifically mention the terminology websites, but does teach remote access of computer sites.

These remote sites of Lockwood are obviously if not inherently "websites " given the broad Internet definition set forth on page 4 of the instant specification in which the Internet term is said to refer to numerous computer databases and on-line services available for public access for retrieving and/or sending information

#### **(10) Response to Argument**

Regarding the Sokal et al. reference arguments. The declaration by Mr. Satchell submitted 3/2/06 by Mr. Satchell under 37 CFR 1.131 has been considered but is ineffective to overcome the Sokal, Brown, and Small references.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Sokal, Brown, and Small references to either a constructive reduction to practice or an actual reduction to practice.

In regards paragraphs 4 and 5 of the declaration relating to the statements about paragraph 8 of the Satchell declaration filed 8/20/04 and resubmitted 10/22/04, Exhibit A of these declarations, provides a variety of dates making it difficult to discern what period of time various events occurred and how they support conception and/or diligence. For example page 1 of the Exhibit A ( submission to Coca Cola signed by

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Mr. Satchell) is dated 9/18/05 but makes no mention of any "Internet" features and neither do the drawing on page 4 or description on page 5 of Exhibit A. However page 6 (labeled corrected copy) does mention Internet connections but the date is uncertain (two dates 5/26/95 and 8/17/95 but no clear indication when the "correction" was made). Further paragraph 8 of the previous declaration ( 8/20/04, 10/22/04) clearly indicates that Exhibit A is a composite of a submission to Coca Cola and additional material, it does not state that all this material was actually submitted to Coca Cola.

In regards to paragraphs 6- 8, as pointed out previously the physical file for abandoned parent application 08/429583 must be consulted to determine various dates since dates appear on both the front and back of various documents in the application. The Image File Wrapper referred to in the Robins declaration is for the child 09/686,626 application and not for the 08/429583 application, since the parent 08/429583 application has not been scanned. In paragraph 7, applicant urges that the document was submitted by fax on 11/8/95, the examiner is unable to determine how applicant arrived at this conclusion. The original documents in the application file 08/429583 appear to be part of the documents received by mail on. 12/26/95 not a fax received on 11/8/95.

In regards to paragraph 9 of the declaration, the copies are acknowledged as being the best applicant is able to provide. The meaning in Exhibit E, which is an attachment to the declaration filed on 8/20/04 and resubmitted 10/22/04 , regarding the last 5 handwritten lines do not appear to have been addressed by applicant in the

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declaration. Specifically what is the continued act to the drawings ( what drawings?, since no drawings are in the exhibit ) and what was stamped by the USPTO ?

In view of the declarations submitted 10/22/04 and 3/2/06 by Mr. Satchell and upon reconsideration the supplemental declaration by Dora Stroud appears to show Mr. Satchell conceived the use of a vending machine as a doorway for the public to reach websites, but fails to establish conception of the invention in that the means themselves and their interaction must be comprehended also.

In response to applicant's arguments, the original claim and drawings in the 08/429,583 application lacked any mention of Internet features. Note for example the office action mailed 3/19/96, paragraph 5, makes no mention of any Internet features as well as the claim and "drawings prints as originally filed". Even the faxed claim copy of 8/17/95 makes no mention of the Internet. Note is also taken that in the office action of 3/19/96, that the claim of the 08/429583 application was rejected under 35 U.S.C. 112 first paragraph as follows:

"Applicant has failed to disclose how the various listed parts operate together to perform the desired result. For example, how does the data control unit, VCR player, satellite receiver, laser-disc player, camera system, cassette dispenser, selection panel, digital counter, satellite antenna, speakers, video screen, and motion detector interrelate or cooperate to perform the desired functions. No block diagrams or wiring of the apparatus connecting these various elements has been disclosed. " Similar reasoning in regards to the Internet features in combination with the vending applies, as explained

above. Further neither Section 2(2) or 7(B) of the original specification in the 08/429,583 application mentions www or Internet access.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Sokal reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The Satchell declaration of 8/20/04,10/22/04 in paragraphs 6-7 appears to show that the internet with worldwide web concept was just emerging and that it proposed the use of a vending machine as a doorway for the public to reach websites, but fails to establish that the necessary means and their interactions to accomplish the desired results were known. Paragraph 7 specifically acknowledges that the concept of the internet was just emerging and paragraph 13 also appears to show that the necessary means and their interaction were not yet known. Paragraphs 21 and 24 of the declaration also provide evidence that the interaction between the various means to accomplish the intended functions were not known.

The Satchell declaration of 8/20/04,10/22/04 in paragraph 8 it is not clear as to what applicant means by additional drawing/written description, or when the additional material was added and to what it was added to. Note for example the "corrected copy" page 6 in Exhibit A for example.



The declaration by Mr. Satchell is insufficient to establish diligence for the period prior to the filing date of the Sokal, Brown, Small, and Hill, III references to the constructive reduction to practice by the filing of the 08/715232 application.

As a particular example diligence has not been shown for the period from just prior to the filing date of 10/10/95 of the Sokal reference to the March 19, 1996 rejection in the 08/429583 application, after the rejection of March 19, 1996 it appears applicant was diligent in filing the 08/715232 application which was the constructive reduction to practice and contained Internet features as originally filed. The entire time period from just prior to the filing date of 10/10/95 of the Sokal reference to the March 19, 1996 rejection must be accounted for by either affirmative acts or acceptable excuses to overcome the Sokal reference. See MPEP 2138.06. For example the time period such as November 14-16, etc. have not been accounted for. The work relied upon must be directed to attaining a reduction to practice of the subject matter of the counts. It is not sufficient that the activity relied on concerns related subject matter. *Gunn vs. Bosch* 181 USPQ 292.

Remarks: one of the critical dates applicant's appear to be trying to swear behind is the filing date of the Sokal reference, while Hurricane Opal could certainly be an acceptable excuse for various delays. Factual evidence to support diligence prior to such a critical date, such as the filing date of Sokal, is still required even if conception has been shown. The examiner can not speculate whether any delay is a result of inexcusable inactivity on the part of the applicants or for excusable inactivity. To illustrate this point, this might be somewhat over simplified in, the statement that

Hurricane Opal arriving on 10/5/95 does not automatically provide a showing of diligence by applicant from 10/5/95 prior to the critical date of 10/10/05 of the Sokal reference absent factual proof.

The amendment filed 12/26/95 in parent application 08/429,583 is not either an actual reduction to practice or a constructive reduction to practice as in the case of filing an U.S. patent application. The filing of the U.S. 08/715,232 application is the constructive reduction to practice. Note MPEP sections 715-715.07(c) and 37 CFR 1.131(b).

Note is also taken that in the papers submitted 12/26/95 in the 08/429,583 application that the cover sheet specifically refers to "modifications, amendments, and supplements containing additional subject matter" these papers introduce the term Internet and also introduce new matter which is not supported by the original 08/429,583 application as filed. New matter is prohibited under 35 U.S.C. 132 and 37 CFR 1.131 (b). Also note In re Costello 219 USPQ 389 which deals with conception..

Further in regards to the amendment filed 12/26/95 in the 08/429,583 application, the only places the internet/ world wide web are mentioned are in paragraphs 2(2) and 3 on page 3; paragraph 5(B) and 7(B) on page 4; paragraph 14 on page 5a; page 6; and element (5B) on page 2 of the drawings also submitted on 12/26/95. These parts of the amendment fail to establish a reduction to practice prior to the Sokal 5,953,504, Brown 5,445,295, Small 5,513,117, and Hill et al. 5,646,819 effective filing dates all of which are prior to the 12/26/95 date.

Applicant's arguments in regards to conception have been noted but are not persuasive. Declarations filed under 37 CFR 1.131 provide various ways to establish prior invention and are set forth in MPEP section 715.07. Among them conception prior to the effective date of the reference, along with due diligence from prior to the reference date, to either an actual reduction to practice or to the filing date of the application (constructive reduction to practice). Conception by itself, is not a complete invention, and confers no rights to an inventor. Further applicant's comments in regards to interference practice have been noted, a declaration filed under 37 CFR 1.131 only has similarities to interference practice and the examiner recognizes this fact and never intentionally suggested that they were the same. Also note MPEP sections 2138.04-2138.06 which also explain conception, diligence, and reduction to practice.

Also in response to applicant's arguments about the combination of Bradt et al. and Sokal, the front exterior of the door of Bradt provides customer interactive features just as the front of device of Sokal provides the customer interactive features on the front making it obvious to put the customer interactive features on the front of the door of the device of Bradt and Sokal.

Also it is noted that applicant provides a special definition of "Internet" which is set forth on page 4 lines 39-42 of the instant specification and which must be given weight when interpreting the claim language. Also the meaning of the terms of website or homepage used in the claims should also be viewed in light of the specification, at page 2, lines 2-4, 16-17, and 55-64, for a proper understanding of the claimed invention.

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The examiner believes then when the paper copy of the grandparent application 08/429,583 which was filed by only one of the instant application's joint inventors; the paper file record of the parent application 08/715,232 filed by the instant joint inventors and which was a continuation in part of the 08/429583 application filed by a sole inventor; the file record of the instant reissue application; and the arguments set forth above are reviewed that the rejections of record should be sustained.

Respectfully submitted,

*Steven R. Garland*

Steven R. Garland

Conferees:

Leo Picard SPE

Lynne Browne SPE

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